

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

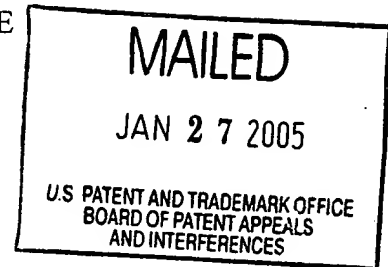
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLAUDIA PANZER, HOLGER TESMANN,
and
ROLF WACHTER

Appeal No. 2004-1535
Application No. 09/830,918

ON BRIEF



Before WILLIAM F. SMITH, TIMM, and ADAMS, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

ON REQUEST FOR REHEARING

Appellants request rehearing of our Decision mailed August 31, 2004 wherein we affirmed the Examiner's decision to maintain a rejection of claims 8-27 for obviousness under 35 U.S.C. § 103(a).

Appellants argue that we misapprehended or overlooked two particular points in rendering our Decision. First, Appellants argue that we misconstrued the precise holding of *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955)(Request, p. 2). Second, Appellants argue that the cited prior art does not recognize the concentration of ethanol as a result-effective variable that can be "routinely optimized." (*Id.*). We are not persuaded on either point.

With regard to *In re Aller*, Appellants argue that “the prior art considered in that case disclosed a range of temperatures overlapping, or at least touching, the range claimed by appellants in that case (i.e., from 40 to 80° C).” (Request, p. 2). Appellants state that “[c]ontrary to the Board’s position taken in the instant appeal, *In re Aller* does NOT stand for the proposition that a particular temperature or concentration value outside of a claimed range supports a conclusion of obviousness.” (*Id.*).

We disagree with Appellants’ characterization of the facts in the case of *In re Aller*. The court in *In re Aller* expressly stated that “[t]he process of appellants is identical with that of the prior art, except that appellants’ claims specify *lower temperatures* and *higher sulphuric acid concentrations* than are shown in the reference.” *Aller*, 220 F.2d at 454, 105 USPQ at 234. Contrary to the statements of Appellants, there is no discussion of a range overlapping or encompassing the claimed range of temperature. Appellants refer to footnote describing the only experiment described in the reference, an experiment in which the reactants are brought, along with sulfuric acid, to a temperature of 100°C. While the footnote indicates that the temperature in a condenser was 60 °C, the court rightly focused on the temperature of 100 ° C in comparing the claimed invention with the prior art. This is because the claim is not directed to the temperature in the condenser, but to the temperature at which the reactants are brought into contact with the sulfuric acid. It is this temperature which the claim required to be 40-80° C whereas the prior art example was conducted at 100° C. The court relied upon the discussion in the reference of the general conditions of the process as evidence of obviousness, the court did not rely not upon a

discussion of any overlapping ranges. The court stated that “where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *Aller*, 220 F.2d at 456, 105 USPQ at 235. Moreover, other cases support obviousness where there is no overlap in ranges but a more general discussion. See *In re Huang*, 100 F.3d 135, 139, 40 USPQ2d 1685, 1688-89 (Fed. Cir. 1996)(affirming the rejection of claims requiring thickness ratios above those employed in the prior art); *In re Schwarze*, 536 F.2d 1373, 1377, 190 USPQ 294, 296 (CCPA 1976)(affirming an obviousness rejection of a claim to a chemical process in which the first stage was conducted at 0-50° C when the prior art process conducted the first stage at 60-90° C); *In re Hill*, 284 F.2d 955, 958-59; 128 USPQ 197, 199 (CCPA 1960) (affirming an obviousness rejection of a claim to a chemical process conducted at 150-250° C when the prior art disclosed the same reaction at 300° C).

As we explained in our Decision, Keil describes the general requirements of the claimed cosmetic preparation in such a way that one of ordinary skill in the art would have found it obvious to perform routine experimentation to determine the optimum or workable ranges for the concentrations of the various ingredients (Decision, p. 5). Appellants argue that our reliance on certain statements in Keil as providing disclosure of “general conditions” was misplaced (Request, p. 3). This is because, according to Appellants, Keil does not specifically disclose or exemplify “water-free” compositions which contain ethanol. But the fact that there are no examples of water-free formulations meeting the concentrations set forth in the claim does not negate the general teaching in Keil that “[t]he composition ... is preferably prepared in aqueous, or in aqueous-

alcoholic media, however, it is also possible to provide it as a water-free preparation” without limitation on the concentrations (Keil, col. 4, ll. 4-6). This general discussion encompasses formulations containing a wide range of alcohol concentrations.

Appellants’ second argument is likewise unconvincing. Appellants seem to believe that the reference must explicitly state that a parameter is a result effective variable in order for one of ordinary skill in the art to understand that the parameter can be adjusted to optimize a formulation. That is not the case. Sometimes it is the disclosure of a range for a parameter such as temperature or concentration, the effect either being understood by those in the art or easily determinable through routine experimentation. Other times, it is the disclosure of a correlation between a parameter and a property which indicates that the parameter was understood to be a result effective variable. *See In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). Each case must be decided on its own facts. Here, Keil discloses that the composition can be prepared in a number of different solvent media including water, water-alcohol, and water-free formulations (Kiel, col. 4, ll. 4-6). A number of alcohols can be used, one of which is ethanol (Kiel, col. 4, ll. 7-11). The examples illustrate different formulations with different solvent media at various concentrations for different products. The reference as a whole provides evidence that the solvent media choice and its concentration was understood by those of ordinary skill in the art to be a result effective variable.


Stepping back for a moment, whether or not the facts of this case parallel those of *Aller* or whether a “rule” formulated from a particular case is met diverts attention from the primary question we must answer under the statute: Whether the differences between the claimed invention and the

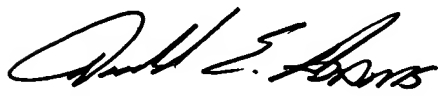
prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a)(2002). In our analysis we relied upon the particular facts of this appeal to determine the question of obviousness. We stand by that determination.

The subject request has been granted to the extent that our decision has been reconsidered, but is denied with respect to making any changes therein.

DENIED


WILLIAM F. SMITH
Administrative Patent Judge


CATHERINE TIMM
Administrative Patent Judge


DONALD E. ADAMS
Administrative Patent Judge

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